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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,529	05/09/2006	Samir F. Saba	UPITT-09379	7228
23535 7590 08/14/2007 MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			EXAMINER SMITH, TERRI L	
			ART UNIT 3762	PAPER NUMBER
			MAIL DATE 08/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/535,529

Applicant(s)

SABA, SAMIR F.

Examiner

Terri L. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-10 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11-24-06</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, Applicant is required, in reply to this Action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 6–10, drawn to a method.

Group II, claim(s) 27–35, drawn to a device.

2. The inventions listed as Group I (method) and Group II (apparatus) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The method does not require the special technical feature of an implantable defibrillator element connected to a pacemaker element, but can be strictly used as a pacemaker for pacing.

3. During a telephone conversation with Thomas C. Howerton on Monday, August 06, 2007 a provisional election was made with traverse to prosecute the invention of Group II, claims 27–35. Affirmation of this election must be made by Applicant in replying to this Office Action. Claims 6–10 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference character 40 in Figure 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR

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1.121(b) are required in reply to the Office Action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office Action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the Applicant regards as his invention.

6. Claims 27–35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 27 recites the limitation "said pacemaker element". There is insufficient antecedent basis for this limitation in the claim.

In claim 28, the phrase "a microprocessor" is inferentially included and it cannot be determined if the microprocessor is being positively recited or functionally recited. To positively claim the microprocessor, it is suggested to first positively recite the microprocessor. Otherwise, functional language such as "for" or "adapted to be" should be used.

Claim 32 recites the limitation "said pacemaker element". There is insufficient antecedent basis for this limitation in the claim.

Claim 33 recites the limitation "said pacemaker element". There is insufficient antecedent basis for this limitation in the claim.

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In claim 34, the phrase “capable of” is vague and indefinite. It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the Applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the Applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 27–35 are rejected under 35 U.S.C. 102(b) as being anticipated by Warman et al., U.S. Patent 6,091,988.

9. Regarding claims 27, 29, 31, 32 and 34, Warman et al. disclose an implantable pacemaker, an implantable defibrillator element and a plurality of atrial and ventricular sensing leads (e.g., FIGS. 1–2); configured to detect an earliest arriving electrical signal (e.g., column 8, lines 8–12 where it is noted that the claim only states that the signals are “detected” and not processed to determine the earliest arriving electrical signal; additionally, both leads will “detect” the earliest arriving electrical signal when in the detection configuration); generates anti-tachycardia pacing burst (claim 29) (e.g., column 4, lines 64–66).

10. With respect to claim 34, converting an abnormal heart rhythm into normal sinus rhythm is inherently realized when anti-tachycardia pacing is administered because the result of said

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pacing makes the heart beat normal which is what normal sinus rhythm is (i.e., a normal heart beat).

11. Regarding claims 28, 30, 33 and 35, Warman et al. disclose a microprocessor (claim 28) and a storage memory (claim 33) (e.g., elements 224 and 226, respectively; column 6, lines 16–39); a blanking period (claim 30) (e.g., FIG. 2, BLANK and BLANK); sensing leads are quadripolar (claim 35) (e.g., elements 311, 320, 318 and 310).

12. Claims 27–35 are rejected under 35 U.S.C. 102(e) as being anticipated by Burnes et al., U.S. Patent Application Publication 2003/0204209.

13. Regarding claim 27, 29, 31, 32 and 34, Burnes et al. disclose an implantable pacemaker, an implantable defibrillator element and a plurality of atrial and ventricular sensing leads (e.g., FIGS. 1–2); configured to detect an earliest arriving electrical signal (e.g., paragraph [0042] where it is the Examiner's position that because continuous detection is being performed, the earliest arriving electrical signal is automatically detected); initiate an anti-tachycardia pacing burst and detect an earliest arriving electrical signal (e.g., FIGS. 3–5); defibrillator generates anti-tachycardia pacing burst (claim 29) (e.g., element 230; paragraph [0008], lines 1–4; paragraph [0023], lines 3–8; paragraph [0037]); converting an abnormal heart rhythm into normal sinus rhythm (claim 34) (e.g., paragraph [0010], lines 8–11). Additionally, normal sinus rhythm is inherently realized when anti-tachycardia pacing is administered because the result of said pacing makes the heart beat normal which is what normal sinus rhythm is (i.e., a normal heart beat).

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14. With respect to claims 28, 30, 33 and 35, Burnes et al. disclose a microprocessor (claim 28) and a storage memory (claim 33) (e.g., elements 224 and 226, respectively; paragraph [0030], lines 1–14); a blanking period (claim 30) (e.g., FIG. 2, A BLANK and B BLANK); sensing leads are quadripolar (claim 35) (e.g., elements 311, 320, 318 and 310).

*Conclusion*

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Terri L. Smith whose telephone number is (571) 272-7146. The Examiner can normally be reached on 7:30 a.m. - 4:30 p.m..

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



TLS

August 13, 2007

13 August 2007

GEORGE R. EVANISKO  
PRIMARY EXAMINER

8/13/07